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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------|---------------------|------------------|
| 08/486,070 | 06/07/1995 | JANNIS G. STAVRIANOPOULOS | ENZ-7(P)(C3) | 6279 |

28170 7590 07/02/2003

ENZO DIAGNOSTICS, INC.
C/O ENZO BIOCHEM INC.
527 MADISON AVENUE 9TH FLOOR
NEW YORK, NY 10022

EXAMINER

MARSCHER, ARDIN H

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1631

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/486,070

Applicant(s)

Stavrianopoulos et al.

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 4/10/02, 6/17/02, 9/4/02, 11/8/02, 12/3/02, 12/4/02, & 12/6/02

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1576-2160 is/are pending in the application.

~~4a) Of the above, Claim(s) 1-1575 have been canceled~~ ~~is/are withdrawn from consideration~~

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1576-2160 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☒ Interview Summary (PTO-413) Paper No(s). 46

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) ☐ Other:

Since this application is eligible for the transitional procedure under 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous office action, mailed 10/10/01, has been withdrawn pursuant to 37 CFR 1.129(a). Applicants' submissions, filed as noted below, have been entered.

Applicants' arguments, filed 4/10/02, 6/17/02, 9/4/02, 11/8/02, 12/3/02, 12/4/02, and 12/6/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The amendment, filed 4/10/02, has been approved for entry and has been entered.

ABSTRACT

The Abstract, filed 4/10/02, of the Disclosure is objected to because it exceeds 150 words. A new shorter abstract is required without the presence of NEW MATTER, submitted on its own separate sheet of paper. Correction is required. See M.P.E.P. § 608.01(b).

NEW MATTER IN THE ABSTRACT OF THE SPECIFICATION:

The amended abstract, filed 4/10/02, is objected to under 35 U.S.C. § 132 because it introduces new matter into the

disclosure. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The again newly submitted abstract, filed 4/10/02, again describes broadened array practice to include any array surface. The array practice, as originally filed, is limited to arrays that are comprised of separate hybridization solutions and/or mixtures at each different substrate location which is narrower in disclosure than the present array description in the abstract which includes any array of different hybridization probes, flat arrays, etc. are therefore included whereas the arrays which were disclosed, as originally filed, requires separate hybridization mixture solutions and therefore cannot be flat and cannot permit one hybridization solution to flow over multiple immobilized hybridization probe locations. Additionally, there is no written basis as filed for the probes at each different location being either the same, different, or whatever comparatively. Therefore the "different" sequences between array surfaces or locations is also NEW MATTER. Therefore said newly submitted abstract contains NEW MATTER. This was also summarized in the previous office action, mailed 10/10/01.

Applicants are required to cancel the new matter in the reply to this Office Action.

NEW MATTER IN THE CLAIMS

Claims 1576-2160 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The again newly submitted abstract, filed 4/10/02, again describes broadened array practice to include any array surface as do claims 1266-1575. The array practice, as originally filed, is limited to arrays that are comprised of separate hybridization solutions and/or mixtures at each different substrate location which is narrower in disclosure than the present array description in the abstract which includes any array of different hybridization probes, flat arrays, etc. are therefore included whereas the arrays which were disclosed, as originally filed, requires separate hybridization mixture solutions and therefore cannot be flat and cannot permit one hybridization solution to flow over multiple immobilized hybridization probe locations. Additionally, there is no written basis as filed for the probes at each different location being either the same, different, or whatever comparatively. Therefore the "different" sequences between array surfaces or locations is also NEW MATTER. Therefore said newly submitted abstract contains NEW MATTER. This was also summarized in the previous office action, mailed

10/10/01. Applicants' charts regarding do not correspond to the written array basis as filed as noted above and as summarized in the previous office action, mailed 10/10/01. It is also noted that nothing on the charts supports "different" hybridization probes at the different array locations.

The Declaration of Dr. Stavrianopoulos, filed 6/17/02 is noted but describes disclosures, such as several exhibits, which do not have basis as filed. The determinative disclosure is the instant specification, abstract, and claims as filed. Other exhibits, disclosures, etc. are moot due to a lack of being submitted in the original filing of the instant application. Equivalently, the Declaration of Dr. James G. Wetmur cites publications, not filed in the instant application which are therefore moot regarding the lack of written basis as filed for the generic array claims. Dr. Wetmur also points to publications regarding immunology which are not seen as being pertinent due to being of a different subject area from the instantly claimed subject matter. Dr. Wetmur also emphasizes several disclosures supporting he well, depressions, etc. as instantly disclosed which has been previously acknowledged and do not cure the lack of written description of the generic arrays as now claimed. Applicants have also submitted post-filing publications regarding arrays, filed 12/6/02. As they are post-filing these are moot regarding the lack of written basis as filed of generic arrays as

now claimed.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

June 27, 2003

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER